REMARKS

Claims 1 through 14 are pending and rejected in this application.

Responsive to the rejection of claims 1-14 under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of U.S. Patent No. 4,593,444 (Kavthekar) and U.S. Patent No. 4,820,240 (Girguis), Applicants respectfully traverse the rejection.

Claim 1 recites in part "forming a . . . bearing roller" by "hard turning the inner surface of the bore . . . thereby forming an inner bearing surface" and "hard turning the lateral surface of the blank to a specified outer diameter, thereby forming an outer bearing surface concentric with said inner bearing surface". (*Emphasis Added*). Applicants submit that such limitations are not shown or suggested by the cited references, alone or in combination.

As the Examiner acknowledges, AAPA does not disclose a roller bearing having inner and outer surfaces formed by hard turning. Thus, AAPA fails to disclose or suggest a roller bearing having concentric inner and outer surfaces formed by hard turning.

As the Examiner further acknowledges, neither the AAPA or Kavthekar disclose a roller bearing having inner and outer surfaces formed only by turning. Thus, AAPA and Kavthekar fail to disclose or suggest a roller bearing having inner and outer surfaces formed by hard turning.

Girguis discloses a joint having outer part 120 (*Fig. 3*), cage 340 and inner part 560. Guide surface 3' of cage 340 contacts bearing surface 2' of outer part 120, and guide surface 5' of inner part 560 contacts bearing surfaces 4' of cage 340, at the end of their widths. The adjoining surfaces of revolution 21 and 41 are produced coaxially with the adjacent bearing surfaces (2' and 4') in one chucking operation, for example by means of grinding. The parts of the bearing surfaces (2' and 4') in contact with the guide surfaces (3' and 5') can also be produced by means of grinding or turning. (*column 8, lines 21-31*).

In contrast to claim 1, Girguis discloses merely exemplary methods of how the centering surfaces of a cage and the centering surfaces of inner and outer parts of a joint are formed. The centering surfaces, although referred to as bearing surfaces, are not the surfaces of a roller bearing. Girguis does not disclose a method of forming a roller bearing. Further, Girguis does not disclose a method of forming an inner surface and lateral surface of a roller bearing. Moreover, Girguis does not disclose grinding the inner and outer surfaces of a blank to specified respective diameters to thereby form a roller bearing having an outer bearing surface that is concentric with an inner bearing surface. Thus, Girguis fails to disclose or suggest forming a bearing roller by hard turning the inner surface of the bore thereby forming an inner bearing surface, and hard turning the lateral surface of the blank to a specified outer diameter thereby forming an outer bearing surface concentric with the inner bearing surface, as recited in part by claim 1.

Since the cited references do not disclose or suggest, alone or in combination, the limitations recited in claim 1, Applicants submit that claim 1 and claims 2-14 depending therefrom are in condition for allowance and respectfully request same.

Further responsive to the rejection of claims 1-14 under 35 U.S.C. §103(a) as being unpatentable over Applicants' Admitted Prior Art (AAPA) in view of U.S. Patent No. 4,593,444 (Kavthekar) and U.S. Patent No. 4,820,240 (Girguis), Applicants respectfully submit that a *prima facie* case of obviousness has not been established.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) (*Emphasis Added*). Thus, if the references do not provide the suggestion or motivation to combine, a *prima facie* case of obviousness has not been established.

As the Examiner acknowledges, neither the AAPA or Kavthekar disclose or suggest forming the inner and outer surfaces by hard turning. Neither does Girguis, as discussed above, suggest forming the inner and outer surfaces of a roller bearing by hard turning. Thus, none of the cited references provide a suggestion or motivation for forming the inner and outer surfaces of a roller bearing by hard turning. Since none of the

cited references provide such a suggestion or motivation, Applicants submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the rejection and allowance of the pending claims.

For all the foregoing reasons, Applicants submit that no combination of the cited references teaches, discloses or suggests the subject matter of the pending claims. The pending claims are therefore in condition for allowance, and Applicants respectfully request withdrawal of all rejections and allowance of the claims.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefore and authorize that any changes be made to Deposit Account No.50-0831, DELPHI TECHNOLOGIES, INC.

The Examiner is invited to telephone the undersigned in regard to this Amendment and the above identified application.

Respectfully submitted,

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